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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,152	07/14/2006	Naoto Kuroda	Q95967	5614

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SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER
WONG, JOSEPH D

ART UNIT	PAPER NUMBER
2166	

NOTIFICATION DATE	DELIVERY MODE
12/12/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@sughrue.com
kghyndman@sughrue.com
USPatDocketing@sughrue.com

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>17 November 2008</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-3</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-3</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>14 July 2006</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
         application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>20081117, 20080717</u>

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____

5)☐ Notice of Informal Patent Application

6)☐ Other: _____

DETAILED ACTION

Requirement Under 37 CFR 1.105

Applicant and the assignee of this application are required under 37 CFR 1.105 to

provide the following information that the examiner has determined is reasonably necessary to

the examination of this application. The justification for this request is that an instant search

report submitted on 6 June 2008 cites the following documents but appropriate copies and

machine translations have not been provided. Therefore appropriate copies and machine

translations are hereby requested.

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JP 2002-334013 A  (Sharp Corp.),
22 November, 2002 (22.11.02),
Full text; Figs. 1 to 11
(Family: none)

JP 11-39341 A  (NEC Corp.),
12 February, 1999 (12.02.99),
Full text; Figs. 1 to 8
(Family: none)

JP 5-165775 A  (NEC Corp.),
02 July, 1993 (02.07.93),
Full text; Fig. 1
(Family: none)
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The fee and certification requirements of 37 CFR 1.97 are waived for those documents

submitted in reply to this requirement. This waiver extends only to those documents within the

scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete

communication responding to this requirement. Any supplemental replies subsequent to the first

communication responding to this requirement and any information disclosures beyond the scope

of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of

37 CFR 1.97.

The applicant is reminded that the reply to this requirement must be made with candor

and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain

an item of requirement information, a statement that the item is unknown or cannot be readily

obtained may be accepted as a complete reply to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete reply to the

enclosed Office action must include a complete reply to this requirement. The time period for

reply to this requirement coincides with the time period for reply to the enclosed Office action.

Information Disclosure Statement

The listing of references in the Search Report is not considered to be an information

disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible

copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed;

(3) for each cited pending U.S. application, the application specification including claims, and

any drawing of the application, or that portion of the application which caused it to be listed

including any claims directed to that portion, unless the cited pending U.S. application is stored

in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which

caused it to be listed. In addition, each IDS must include a list of all patents, publications,

applications, or other information submitted for consideration by the Office (see 37 CFR

1.98(a)(1) and (b)), and MPEP § 609.04(a), subsection I. states, "the list ... must be submitted on

a separate paper." Therefore, the references cited in the Search Report have not been considered.

Applicant is advised that the date of submission of any item of information or any missing

element(s) will be the date of submission for purposes of determining compliance with the

requirements based on the time of filing the IDS, including all "statement" requirements of 37

CFR 1.97(c). See MPEP § 609.05(a).

Priority

The justifications for the request to perfect foreign priority are as follows:

o An intervening date reference of Wang has been applied but would be removed if

foreign priority is later if priority is granted and if priority is perfected.

o Applicant has provided a foreign priority Japanese document appears to show seven

figures while the instant English application shows two additional figures which suggest that the

subject matter of the instant application appears not supported in its entirety.

Therefore a certified translation of every foreign benefit application or Patent

Cooperation Treaty (PCT) application not filed in English is required. 35 U.S.C. 119(b)(3) and

372(b)(3) and 37 CFR 1.55(a)(4). If no certified translation is in the official record for the

application, the examiner must require the applicant to file a certified translation. The applicant

should provide the required translation if applicant wants the application to be accorded benefit

of the non-English language application. Any showing of priority that relies on a non-English

language application is prima facie insufficient if no certified translation of the application is on

file. 37 CFR 41.154(b) and 41.202(e). Form paragraph 23.19 may be used to notify applicant

that a certified English translation of the priority document is required. See MPEP 2304.01(b)

Translation of Foreign Benefit Application.

Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-

(d) prior to declaration of an interference, a certified English translation of the foreign

application must be submitted in reply to this action, 37 CFR 41.154(b) and 41.202(e).

Failure to provide a certified translation may result in no benefit being accorded for the

non-English application.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
requirements of this title.

Claim 2 is rejected for being directed towards nonstatutory subject matter.

Claim 2 is directed toward a data structure for judging whether a computer apparatus is

connected to a network. This apparatus claim does not necessarily recite a physical article within

the body of the claim. Consequently it appears directed towards software per se. Therefore

claim 2 is rejected.

Applicants can look to MPEP 2106.01-2106.02 (July 2008), Interim Guidelines for

Examination of Patent Applications for Patent Subject Matter Eligibility, Instant Specification,

and contemporary case law with a matching fact pattern for further suggestions that may be

helpful in overcoming these rejections.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Csipkes et al, (US 6,167,401), hereinafter Csipkes.

As to claim 1, Csipkes teaches a network connection presence/absence judging method of judging whether a computer apparatus is connected to a network (Fig. 9, item 912; Fig. 1, item 107), the network connection presence/absence judging method (Fig. 1) comprising: a step of detecting positional information of predetermined data included in an external device connected to the network (Figs. 9, 6a; Col. 3, Lines 10-15; Fig. 2; Col. 3, Lines 9-15), the positional information being described in a hypertext read from a storage medium (Fig. 3a, item 105, "scan serial number"); a step of displaying (Figs. 5b, 6a, 6b, 8, see serial number "BOARD SN...B1001206"), in accordance with the hypertext (Fig. 5c, 6a, "Details" button; Fig. 8, "BOARD SN" button), a connection presence/absence judgment screen including a message indicating that the predetermined data is displayed in a predetermined position when the computer apparatus is connected to the network (Fig. 6b, "ensure excess wire is clipped at ends after soldering"); and a step of displaying (Fig. 10; Col. 5, Lines 5-10, 20-30; Fig 3c, item 123,

"display work instructions, graphics and warnings"), when the predetermined data is successfully

acquired from the external device (Fig. 6a), the predetermined data in the predetermined position

in the connection presence/absence judgment screen (Col. 5, Lines 33-40, "test results fall

outside of control specifications"; Figs. 5b-c), and displaying (supra; Fig 3c, item 123, "display

work instructions, graphics and warnings"), when the predetermined data is not successfully

acquired from the external device (Fig. 3c, item 133, "test prob(sic)"; refers to test problem; Fig.

5b, see tray#), alternative data decided in advance in the predetermined position in the

connection presence/absence judgment screen (Fig. 3c, items 134-5, "auto manuf. (sic) prob.

(sic)...manual assem. (sic) probl. (sic)"; see pass/fail display in Fig 5b).

      As to claim 2, Csipkes teaches a data structure for judging whether a computer apparatus

is connected to a network (Fig. 9, item 912; Fig. 1, item 107), the data (Fig. 3c, items 124-125,

dotted line rectangles) structure comprising: a message tag that is a tag for describing (Fig. 5c,

6a, "Details" button; Fig. 8, "BOARD SN" button, where text on button or label meets tag),

when the computer apparatus is connected to the network (Figs. 9, 6a; Col. 3, Lines 10-15; Fig.

2; Col. 3, Lines 9-15), a message indicating that predetermined data is displayed in a

predetermined position (Figs. 5b, 6a, 6b, 8, see serial number "BOARD SN...B1001206"); and a

positional information tag that is a tag for describing positional information of the predetermined

data included in an external device connected to the network (Fig. 6b, "ensure excess wire is

clipped at ends after soldering"), and the data structure causing the computer apparatus to

execute: a step of detecting positional information of the predetermined data on the basis of the

positional information tag (Fig. 5c, 6a, "Details" button; Fig. 8, "BOARD SN" button, where text

on button or label meets tag); a step of detecting the message based on the message tag and

displaying a connection presence/absence judgment screen including the message (Fig. 6b,

"ensure excess wire is clipped at ends after soldering"); and a step of displaying (Fig. 10; Col. 5,

Lines 5-10, 20-30; Fig 3c, item 123, "display work instructions, graphics and warnings") when

the predetermined data is successfully acquired from the external device on the basis of the

positional information (Fig. 3a, item 105, "scan serial number"), the predetermined data in the

predetermined position in the connection presence/absence judgment screen (Col. 5, Lines 33-40,

"test results fall outside of control specifications"; Figs. 5b-c) and displaying (supra; Fig 3c, item

123, "display work instructions, graphics and warnings"), when the predetermined data is not

successfully acquired from the external device on the basis of the positional information (Fig.

3c, item 133, "test prob(sic)"; refers to test problem; Fig. 5b, see tray#), alternative data decided

in advance in the predetermined position in the connection presence/absence judgment screen

(Fig. 3c, items 134-5, "auto manuf. (sic) prob. (sic)...manual assem. (sic) probl. (sic)"; see

pass/fail display in Fig. 5b).

     As to claim 3, Csipkes teaches a storage medium for storing a data structure for judging

whether a computer apparatus is connected to a network (Fig. 9, item 912; Fig. 1, item 107), the

data structure comprising: a message tag for describing (Fig. 5c, 6a, "Details" button; Fig. 8,

"BOARD SN" button, where text on button or label meets tag), when the computer apparatus is

connected to the network (Figs. 5b, 6a, 6b, 8, see serial number "BOARD SN...B1001206"), a

message indicating that predetermined data is displayed in a predetermined position (Fig. 6b,

"ensure excess wire is clipped at ends after soldering"); and a positional information tag for

describing positional information of the predetermined data included in an external device

connected to the network (Fig. 6b, "ensure excess wire is clipped at ends after soldering"), and

the data structure causing the computer apparatus to execute: a step of detecting positional

information of the predetermined data on the basis of the positional information tag (Fig. 5c, 6a,

"Details" button; Fig. 8, "BOARD SN" button, where text on button or label meets tag); a step of

detecting the message based on the message tag and displaying a connection presence/absence

judgment screen including the message (Col. 5, Lines 33-40, "test results fall outside of control

specifications"; Figs. 5b-c); and a step of displaying (supra; Fig 3c, item 123, "display work

instructions, graphics and warnings"), when the predetermined data is successfully acquired from

the external device on the basis of the positional information (Fig. 3c, item 133, "test prob(sic)";

refers to test problem; Fig. 5b, see tray#), the predetermined data in the predetermined position in

the connection presence/absence judgment screen and displaying, when the predetermined data is

not successfully acquired from the external device on the basis of the positional information,

alternative data decided in advance in the predetermined position in the connection

presence/absence judgment screen (Fig. 3c, items 134-5, "auto manuf. (sic) prob. (sic)...manual

assem. (sic) probl. (sic)"; see pass/fail display in Fig. 5b).

**Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Wang et al,
(US 2005/0210123 A1), hereinafter Wang.**   This is an intervening date reference whose filing

date appears between Applicant's PCT filing date and the foreign priority date.

As to claim 1, Wang teaches a network connection presence/absence judging method of

judging whether a computer apparatus is connected to a network (Fig. 4, see "green...RPS is

connected to network device and works", paragraph ¶[29]), the network connection

presence/absence judging method comprising: a step of detecting positional information of predetermined data included in an external device connected to the network (Fig. 4, ¶[29]), the positional information being described in a hypertext read from a storage medium (Fig. 1, ¶[21]); a step of displaying (Fig. 1, item 1210, "web browser"), in accordance with the hypertext (Fig. 1, "HTML", [21]), a connection presence/absence judgment screen including a message indicating that the predetermined data is displayed in a predetermined position when the computer apparatus is connected to the network (Fig. 2, ¶[24-25]; Fig. 3A, ¶[30-31], see LED circles; Fig. 4, see green color code, ¶[29]); and a step of displaying (¶[24-25, 30-31]; Figs. 2, 3A), when the predetermined data is successfully acquired from the external device (¶[16, 29], Figs. 3B, 4), the predetermined data in the predetermined position in the connection presence/absence judgment screen (¶[24-25, 30-31]; Figs. 2, 3A), and displaying (supra), when the predetermined data is not successfully acquired from the external device (Fig. 4, "Gray(off)...RPS is not connected to network device"; Fig. 3B, "Gray(off)...Link down"), alternative data decided in advance in the predetermined position in the connection presence/absence judgment screen (¶[24-25, 30-31]; Figs. 2, 3A).

   As to claim 2, Wang teaches a data structure for judging whether a computer apparatus is connected to a network (Fig. 4, see "green...RPS is connected to network device and works", paragraph ¶[29]), the data structure comprising: a message tag that is a tag for describing (¶[23], "Uniform Resource Locator...URLs of image icons"), when the computer apparatus is connected to the network (Fig. 4, [29]), a message indicating that predetermined data is displayed in a predetermined position (Fig. 2, ¶[24-25]; Fig. 3A, ¶[30-31], see LED circles; Fig. 4, see green color code, ¶[29]); and a positional information tag that is a tag for describing positional

information of the predetermined data included in an external device connected to the network
(¶[24-25, 30-31]; Figs. 2, 3A), and the data structure causing the computer apparatus to execute:
a step of detecting positional information of the predetermined data on the basis of the positional
information tag (Fig. 2, ¶[24-25]; Fig. 3A, ¶[30-31], see LED circles; Fig. 4, see green color
code, ¶[29]); a step of detecting the message based on the message tag and displaying a
connection presence/absence judgment screen including the message (¶[16, 29], Figs. 3B, 4); and
a step of displaying (supra), when the predetermined data is successfully acquired from the
external device on the basis of the positional information (¶[29], Fig. 4, "Green....Power is
working...Green....RPS is connected to network device and works"; ¶[26-27], Fig. 3B,
"Green...Link up...Green...Port is operating at 100 Mbps"), the predetermined data in the
predetermined position in the connection presence/absence judgment screen and displaying
(¶[24-25, 30-31]; Figs. 2, 3A), when the predetermined data is not successfully acquired from
the external device on the basis of the positional information (Fig. 4, "Gray(off)...RPS is not
connected to network device"; Fig. 3B, "Gray(off)...Link down". ¶[29]), alternative data decided
in advance in the predetermined position in the connection presence/absence judgment screen
(¶[24-25, 30-31]; Figs. 2, 3A).

    As to claim 3, Wang teaches a storage medium for storing a data structure for judging
whether a computer apparatus is connected to a network (Fig. 4, see "green...RPS is connected to
network device and works", paragraph ¶[29]), the data structure comprising: a message tag for
describing (¶[23], "Uniform Resource Locator...URLs of image icons"), when the computer
apparatus is connected to the network (Fig. 4, ¶[29]), a message indicating that predetermined
data is displayed in a predetermined position (¶[24-25, 30-31]; Figs. 2, 3A); and a positional

information tag for describing positional information of the predetermined data included in an

external device connected to the network (Fig. 2, ¶[24-25]; Fig. 3A, ¶[30-31], see LED circles;

Fig. 4, see green color code, ¶[29]), and the data structure causing the computer apparatus to

execute : a step of detecting positional information of the predetermined data on the basis of the

positional information tag (Fig. 2, ¶[24-25]; Fig. 3A, ¶[30-31], see LED circles; Fig. 4, see green

color code, ¶[29]); a step of detecting the message based on the message tag and displaying a

connection presence/absence judgment screen including the message (¶[16, 29], Figs. 3B, 4); and

a step of displaying (¶[24-25, 30-31]; Figs. 2, 3A), when the predetermined data is successfully

acquired from the external device on the basis of the positional information (¶[29], Fig. 4,

"Green....Power is working...Green....RPS is connected to network device and works"; ¶[26-27],

Fig. 3B, "Green...Link up...Green...Port is operating at 100 Mbps"), the predetermined data in the

predetermined position in the connection presence/absence judgment screen and displaying

(¶[24-25, 30-31]; Figs. 2, 3A), when the predetermined data is not successfully acquired from

the external device on the basis of the positional information (Fig. 4, "Gray(off)...RPS is not

connected to network device"; Fig. 3B, "Gray(off)...Link down", ¶[29]), alternative data decided

in advance in the predetermined position in the connection presence/absence judgment screen

(Fig. 4, "Gray(off)...RPS is not connected to network device"; Fig. 3B, "Gray(off)...Link down",

¶[29]).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph D. Wong whose telephone number is (571) 270-1015. The examiner can normally be reached on Mondays through Fridays from 10 AM – 6PM.

Applicant initiated interviews may be formally requested in advance by faxing a completed PTO-413A form to the examiner's personal fax number at (571) 270-2015. Form PTO-413A is used by the examiner to prepare for any proposed interview. A detailed agenda listing should be attached including any proposed claim language and/or arguments that will be presented. This form is used to determine whether any proposed interview would advance prosecution and fit within a prescribed time limit.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://portal.uspto.gov/external/portal/pair. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JDW/
Asst. Examiner, Art Unit 2166
12 December 2008

/K. B. P./

/Hosain T Alam/
Supervisory Patent Examiner, Art Unit 2166